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Date of Transmission: 1/17/06 By: Stuart Whittington

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Michael Hosey

Atty. Docket: HG-04-01

Appln. Ser. No.: 10/762,674

Group Art Unit: 2835

Filed: January 22, 2004

Examiner: Duong, Hung V.

For: PORTABLE MEDIA DEVICE

PETITION UNDER 37 CFR 1.181 FOR RECONSIDERATION OF PEMATURE FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Advisory Action dated December 27, 2005, denying Applicant's request for reconsideration regarding the prematureness of the Final Rejection dated September 15, 2005, please consider the:

Remarks beginning on page 2.

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REMARKS:

FACTS INVOLVED.

A first Office Action on the merits of this application was mailed 4/5/05, rejecting Applicant's claims for being indefinite under 35 USC 112, second paragraph as well as on grounds of prior art.

Applicant responded to the Office Action by way of Amendment on 7/5/05, traversing the prior art rejections by argument and amending the claims to address the indefiniteness rejection.

Specifically, Applicant amended claim 1 to recite *a portable housing unit* and a *locking retaining ~~portion~~ clip*. These limitations were either already recited in claim 1 or in dependent claim 3 and thus no new limitations were included by way of Applicant's amendment. Only minor inconsistencies were amended to address those raised by the indefiniteness rejection. In regard to independent claim 11, no amendments were presented whatsoever and independent claim 18 was amended to recite *a carabineer clip* which was already present in dependent, now cancelled, claim 20. In essence, Applicant made minor amendments to the claims to be consistent with one another and all limitations included in such amendments were previously present in the originally filed claims.

A Final Office Action was mailed on 9/15/05 which finally rejected all pending claims under new prior art grounds, notably citing US 6,934,568 to Charlier et al. and U.S. Appln. US2005/0116042 to Wilkens in the record for the first time. The previous rejections of record were not reasserted, and admittedly the Office Action presented these references forming new grounds of rejection. (9/15/05 Final Office Action; pg. 3). The Office Action indicated that it was made final because "Applicant's amendment necessitated the new ground(s) of rejection presented."

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In the response filed by Applicant on 12/15/05, Applicant requested reconsideration of the finality of the 9/15/05 Office Action and entry of the amendments presented in the response alleging the 9/15/05 final rejection was premature under MPEP 706.07(a) and (c) because the new grounds of rejection were in no way necessitated by Applicant's actions and should have been presented in the original Office Action.

An Advisory Action was mailed on 12/27/2005 refusing entry of Applicant's response, which included substantive amendments. The Advisory Action did not address Applicant's request for reconsideration of the finality of the 9/15/05 Office Action.

On January 17, 2006, Applicant's representative contacted the Examiner by telephone to determine whether the request for reconsideration was in fact considered. Examiner Hung V. Duong confirmed that Applicant's request for reconsideration had been considered and denied. As understood by Applicant's representatives, Examiner Duong indicated that even one or two insignificant amendments that solely address antecedent basis issues necessitated the new grounds of rejection. Applicant respectfully, but vehemently, disagrees and this petition in accordance with MPEP 1002.02 (c) is presented.

PREMATURENESS OF FINAL ACTION TO BE REVIEWED.

Legal Standard

"[A] second or subsequent action on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement....." MPEP 706.07(a). "A second or any subsequent action on the merits in any application, or patent involved in reexamination proceedings, should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed." MPEP 706.07(a) (emphasis added) referring to searching criteria of MPEP 904. "For example, one would reasonably expect that a rejection under 35

USC 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element." *Id.*

Argument

In the case at hand, every limitation added or varied by way of Applicant's amendment filed on 7/5/05 were already expressly present in the claims originally filed by Applicant. Thus, by the Office's own policies (MPEP 706.07(a); MPEP 904), the limitations present in the claims as amended on 7/5/05 should have been reasonably expected to be claimed and searched in the first action on the merits. The search and examination of the original claims, for which Applicant duly paid, should have resulted in the citation of the newly identified prior art references, if deemed relevant, in the first Office Action dated 4/5/05. In the absence of the Examiner's knowledge or availability of these references, a second non-final action on the merits should have been issued on 9/15/05.

Applicant's response to the first Office Action dated 4/5/05 merely clarified existing claim limitations and did not present a single issue by way of amendment which should have necessitated a new search or new ground of rejection. 37 C.F.R. § 1.116(b). For example, since each claim limitation was expressly present in the originally filed claims, and no claims have been amended to combine claim limitations from claims associated with other independent claims, no new issues could possibly have been presented which differ from the originally filed claims.

The Final Office Action of 9/15/05 now cites two entirely new prior art references (admittedly forming new grounds of rejection) against Applicant's claims. The new references could have been cited against the claims as originally filed but, through no fault of Applicant, were not. MPEP 706.07(a). Through no fault of its own, Applicant has not been afforded a full and fair opportunity to respond to new grounds of rejection without being forced to pay the substantial fees associated with the accompanying RCE and potential loss of patent term adjustment.

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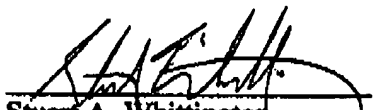
ACTION REQUESTED.

The Commissioner is respectfully requested to: (i) determine the new grounds of prior art rejections in the Office Action dated 9/15/05 were prematurely made final; (ii) allow Applicant's response filed on 12/15/05 to be entered into the record in accordance with non-final action procedures of 37 CFR 1.111; and (iii) entitle Applicant to a refund of the $395 RCE fee and $55 one month extension of time fees (total: $450.00) which were necessarily paid by Applicant as a direct result of the premature final rejection.

CONCLUSION.

Applicant believes that this petition is timely filed in accordance with 37 CFR 1.181(f) and MPEP 1002, i.e., within two months of being denied the request for reconsideration by the primary examiner. Further, Applicant believes no fee is required for this petition under 37 CFR 1.181(d) as the result of exhaustive searching of the MPEP and multiple direct telephone inquiries to the USPTO, including the Office of Petitions, the inventor's assistance hotline and the Director of Technology Group 2835.

Respectfully submitted,



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